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No. 93-1577

IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1994

QUALITEX COMPANY,

Petitioner,

v.

JACOBSON PRODUCTS CO., INC.,

Respondent.

ON WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

PETITIONER'S REPLY BRIEF

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PETITIONER'S REPLY BRIEF

Petitioner, Qualitex Company ("Qualitex"), hereby replies to the brief of Respondent, Jacobson Products Co., Inc. ("Jacobson").

I. JACOBSON AGREES THAT THE LANHAM ACT DOES NOT PROHIBIT REGISTRATION OF COLOR AS A TRADEMARK

Jacobson concedes the only issue certified for review by this Court, stating in the second sentence of its

argument: "Jacobson agrees that color may be protected as a trademark under the Lanham Act." Respondent's Brief at 6. Jacobson also admits that "[i]t is not arguable that the Lanham Act allows the registration of color as a trademark, when the use of color functions as a trademark."[1] Respondent's Brief at 1. Further, Jacobson does not dispute that the legislative history of the Trademark Law Revision Act of 1988, amending the Lanham Act, demonstrates Congress' intention to include colors, shapes, sounds, or configurations among the "symbols or devices" registrable as trademarks. Respondent's Brief at 10-11.

Unable to interpret the Lanham Act or its legislative history in a manner supporting its position, Jacobson quarrels with the factual determinations of the Patent and Trademark Office and the District Court that the green-gold color functions as a trademark of Qualitex: Determinations which the Ninth Circuit left undisturbed.

II. JACOBSON HAS PROVIDED NO BASIS FOR OVERTURNING THE FACTUAL FINDINGS BELOW

The District Court found after trial that "Qualitex has a valid trademark registered on the Principal Register of the Patent and Trademark Office for the green-gold mark . . ." Joint Appendix ("J.A.") 13a. Despite the District Court's express findings, Jacobson argues that the green-gold color does not, in fact, function as a trademark as applied to Qualitex's press pads. Jacobson contends that as a factual

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[1] Supreme Court Rules preclude raising additional questions or changing the substance of the questions certified for review in any brief on the merits. Supreme Court Rules 24.1(a) and 24.2. Since Jacobson has conceded the issue certified for review and is barred by these rules from raising any new issues, it may be appropriate for this Court to summarily reverse the Ninth Circuit on the sole question presented.

matter the green-gold color is functional and will hinder competition if treated as a trademark.[2]

The factual findings of the trier of fact cannot be overturned unless found to be clearly erroneous. Fed. R. Civ. P. 52(a); *Anderson v. City of Bessemer City, N.C.* 470 U.S. 564, 573 (1985); *United States v. General Dynamics Corp.*, 415 U.S. 486, 508 (1974). The Ninth Circuit clearly rejected Jacobson's argument that the District Court's findings were erroneous and declined to overturn them (J.A. 31a - 35a). Moreover, that issue was not appealed to this Court and was not certified for review. Under these circumstances, Jacobson cannot raise the question now. Supreme Court Rule 14.1(a); *Taylor v. Freeland & Kronz*, 112 S. Ct. 1644, 1649 (1992); *Air Courier Conf. v. American Postal Workers Union*, 498 U.S. 517, 522 (1991).

Even if this Court were to review the factual findings below, the record simply does not support Jacobson's position. Jacobson improperly cites trial testimony which did not persuade the District Court.[3] The District Court found that the green-gold color applied to Qualitex's press pads was a trademark (J.A. 13a); that the Patent and Trademark Office had registered the mark (J.A. 7a); and that Jacobson failed to demonstrate that the mark was invalid and should be cancelled

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[2] Notably, this argument by Jacobson is irrelevant to the question presented; namely, whether the Lanham Act prohibits the registration of color as a trademark.

[3] For example, Jacobson attempts to convince this Court that "it was determined to compete fairly with Qualitex . . ." and that Jacobson did not believe that it was passing off its green-gold pads as those of Qualitex. Respondent's Brief at 4. Yet the District Court found that Jacobson's "use of the green-gold color was intended to trade on the goodwill Qualitex has developed in its green-gold trademark" (J.A. 15a). Further, the Court found Jacobson was "deceiving purchasers" and "putting an inferior product into the marketplace under Qualitex's distinctive trade dress." *Id.*

(J.A. 14a). Concerning the validity of the green-gold trademark, the District Court unequivocally found:

> (1) "The green-gold shade of color which distinguishes the Qualitex press pad that is being copied by Jacobson is not legally functional because it is not related in any way to the product's use, cost, quality or longevity"[4] (J.A. 17a);
>
> (2) "In recognizing the [green-gold] trademark as valid there is no danger of 'color depletion.' There are hundreds or thousands of distinctive shades of greens, yellows, blues, and browns or tans available to competitors without danger that recognizing plaintiff's trademark will hinder competition"[5] (J.A. 14a); and

[4] Jacobson claims here, as it did in the District Court, that the use of color on press pads is essential to their saleability and helps obscure the scorch and other marks inflicted during use. Respondent's Brief at 20. The District Court found, however: "Green-gold color dye on the cover material of a press pad does not make the press pad perform better" (J.A. 12a); "The color itself does not affect the quality of the goods one way or the other." *Id*; "The green-gold color dye for cover material is more expensive than other colors." *Id*.

[5] Jacobson argues here as it did at trial that *all* press pad manufacturers color their press pads because white pads are less saleable. From this, Jacobson argues that there is a competitive need for the use of color in the press pad industry which should preclude any manufacturer from claiming the exclusive right to use any particular color. Respondent's Brief at 16. The District Court found, however: "For decades, other manufacturers have used the colors lime green, gray, dark green, light blue, peach, orange, blue/gray and other colors on their press pads" (J.A. 8a); "There is a competitive need in the press pad industry for color, but the range of tones of available, distinctive, suitable colors, which need not be primary colors, is in the hundreds, if not thousands" (J.A. 12a); "There is no competitive need in the press pad industry for the green-gold color, since other colors are equally usable." *Id*.

> (3) "As a result of the long and exclusive use of its green-gold color in the marketplace Qualitex's SUN GLOW® pad has acquired distinctiveness or secondary meaning"[6] (J.A. 8a).

In spite of these dispositive findings, Jacobson conjectures that the green-gold mark has become a generic means of referring to all press pads. Respondent's Brief at n. 19. This argument is new and unsupported by the record below. Whether a mark has become generic is strictly a question of fact. *Bayer Co. v. United Drug Co.* 272 F. 505, 509 (D.C.N.Y. 1921). Not surprisingly, Jacobson has not pointed to any findings which support this position. On the contrary, by finding that the green-gold mark has acquired secondary meaning, the District Court necessarily found that Qualitex's green-gold color trademark is not generic. Jacobson's erroneous argument is exacerbated by its failure to understand the difference between color applied to a product and the product itself. Qualitex has never sought to register or claim rights in the color of the product itself. The natural color of the Qualitex cover material is a yellowed off-white (J.A. 12a). The green-gold color is arbitrarily applied to the cover cloth by Qualitex to identify and distinguish its press pads from those of its competitors.

There is no basis for this Court to rule that the District Court's findings regarding the validity of Qualitex's trademark are erroneous. Jacobson's self-serving version of the

[6] The District Court further found: "Qualitex has sold its press pads in the same green-gold color fabric for over 30 years" (J.A. 7a). "From 1960 through September 30, 1990, Qualitex has expended approximately $1,621,000 for advertising the green-gold color of the SUN GLOW® pad and to promote it at trade shows" (J.A. 8a). "Over the past 30 years, Qualitex has sold over one million SUN GLOW® press pads bearing the green-gold color." *Id*. ". . . Some purchasers of press pads have come to identify and order Qualitex press pads over the telephone by merely describing its color." *Id*.

facts is belied by the undisturbed findings of the courts below and the Patent and Trademark Office. The questions of whether the green-gold color has acquired secondary meaning, is non-functional, and is not needed for competition in the relevant industry are factual issues which have been resolved and may not be challenged by Jacobson at this juncture. *See Roemer v. Board of Public Works of Maryland*, 426 U.S. 736, 758 (1976).

III. JACOBSON'S POLICY ARGUMENTS DO NOT SUPPORT A *PER SE* RULE AGAINST REGISTRATION OF COLOR TRADEMARKS

The issue certified in this case properly asks whether the Lanham Act prohibits color registration. Jacobson's policy arguments do not address this issue. Whether color may be registered as a trademark if it functions as such has been answered by Congress[7] and the Patent and Trademark Office.[8] Jacobson ignores the plain language of the Lanham Act, its legislative history and its administrative interpretation, and relies instead on mere policy arguments to defend the Ninth Circuit's grafting of a *per se* rule against color registration onto the statute. Mere policy arguments cannot prevail over the Lanham Act.

A. JACOBSON DOES NOT HAVE SUBSTANTIAL JUDICIAL SUPPORT FOR ITS POLICY ARGUMENTS

Jacobson claims wide acceptance by the circuit courts of its policy arguments against registration of color trademarks. This is plainly wrong. Two circuit courts have clearly stated the opposite: Color may be protected as a

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[7] *See* Petitioner's Brief at 14-18

[8] *See* Petitioner's Brief at 19-22

trademark. *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 (Fed. Cir. 1985); *Master Distributors, Inc. v. Pako Corp.*, 986 F.2d 219 (8th Cir. 1993). Further, only the Ninth Circuit has ever cancelled a federal registration for a color trademark.

By arguing that *Owens-Corning* is an "extraordinary situation" and should be limited to its facts, Jacobson tacitly concedes that the registrability of color is based on a factual analysis. Where such an analysis is required, a *per se* rule against color registrability would be particularly unsuitable. *Cf. United States v. Topco Assocs., Inc.*, 405 U.S. 596, 607 (1972) (*per se* rules may be appropriate where a particular factor alone leads to a predictable result). Indeed, the District Court found that "[t]he facts in the present case are *remarkably similar to those in Owens-Corning* and therefore also constitute an '*extraordinary*' case to confirm trademark protection to the green-gold color for use on press pads" (J.A. 18a) (emphasis added). Thus, even if *Owens-Corning* is narrowly interpreted, the undisturbed factual findings of the District Court support the Patent and Trademark Office's decision to register Qualitex's green-gold color as a trademark.

Most of the cases cited in support of Jacobson's position do not refuse trademark protection solely because the mark at issue is a color, and none address the question of whether the Lanham Act prohibits registration of overall color as a trademark. In *NutraSweet Co. v. Stadt Corp.*, 917 F.2d 1024 (7th Cir. 1990), *cert. denied*, 499 U.S. 983 (1991), the only cited case to refuse protection based solely on the fact that the mark constitutes a single color, the issue of whether such a mark may be registered under the Lanham Act was not before the Court.[9] All of the other cited cases fail to reach

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[9] Nutrasweet Co. did not register its blue color as a trademark with the U.S. Patent and Trademark Office. A federal registration would have required Nutrasweet Co. (as Qualitex has done in this case) to demonstrate that its color mark had acquired secondary meaning, was non-functional, and

the question presented for one of two reasons: Either the court found on the facts of the case that a claimed proprietary right in a color should be rejected on functionality or non-distinctiveness grounds;[10] or the proprietary right asserted was not a color alone, but a combination of colors, color with a design, or as part of a trade dress scheme.[11] The universal

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did not interfere with any competitive need in the relevant industry. The reported case sheds no light on these subjects except to state Nutrasweet Co. had used the color for only six years.

[10] *See Norwich Pharmacal Co. v. Sterling Drugs, Inc.*, 271 F.2d 569 (2d Cir. 1959), *cert. denied*, 362 U.S. 919 (1960) (unregistered pink color of Pepto Bismol held to be unprotectable on functionality grounds); *North Shore Laboratories Corp. v. Cohen*, 721 F.2d 514 (5th Cir. 1983) (brown color of tire repair material is natural color after manufacturing process and non-distinctive); *First Brands Corp. v. Fred Meyer, Inc.*, 809 F.2d 1378 (9th Cir. 1987) (unregistered yellow antifreeze container trade dress is functional in relevant industry); *In re L. E. Waterman Co.*, 34 App. D.C. 185 (1909) (primary color red not protectable for fountain pen feed bars on non-distinctiveness grounds).

[11] *See Dallas Cowboy Cheerleaders v. Pussycat Cinema*, 467 F. Supp. 366 (S.D.N.Y. 1979), *aff'd*, 604 F.2d 200 (2d Cir. 1979) (unregistered trade dress of the Dallas Cowboys cheerleaders' uniform at issue); *Campbell's Soup Co. v. Armour & Co.*, 175 F.2d 795 (3d Cir. 1949) (unregistered red and white color scheme of the Campbell's soup can at issue); *Quabaug Rubber Co. v. Fabiano Shoe Co., Inc.*, 567 F.2d 154 (1st Cir. 1977) (validity of yellow octagon design mark upheld); *Volkswagenwerk Aktiengesellschaft v. Rickard*, 492 F.2d 474 (5th Cir. 1974) (appellate modification of a trade dress injunction, permitting defendant to use the color blue in signs); *Tas-T-Nut Co. v. Variety Nut & Date Co.*, 245 F.2d 3 (6th Cir. 1957) (unregistered color coding trade dress scheme at issue); *Mershon Co. v. Pachmayr*, 220 F.2d 879 (9th Cir. 1955), *cert. denied*, 350 U.S. 855 (1955) (unregistered mark including a white line as a component at issue); *Life Savers Corp. v. Curtiss Candy Co.*, 182 F.2d 4 (7th Cir. 1950) (unregistered color scheme of multicolored stripes on package of multicolored candy at issue); *In re Canada Dry Ginger Ale, Inc.*, 86 F.2d 830 (C.C.P.A. 1936) (map of Canada featuring design of colored lines refused registration on geographically descriptive grounds); *Sheaffer Pen Co. v. Coe*, 27 F. Supp. 380 (D.C.D.C. 1939) (design including platinum coloring refused registration in part because coloring was non-distinctive color of metal plating used).

deficiency among these cases is their failure to address registrability of a color under the Lanham Act.[12]

Pre-Lanham Act and common law trademark authority does not provide policy support for the Ninth Circuit's *per se* rule since countervailing policies are so clearly expressed in the language of the Act and its legislative history. Twentieth century trademark jurisprudence culminating in the current embodiment of the Lanham Act has clearly developed to protect a broad range of indicia which can identify and distinguish one manufacturer's products from those of others. *See* Petitioner's Brief at 14-16.

B. JACOBSON'S FACTUALLY UNSUPPORTED POLICY ARGUMENTS DO NOT REQUIRE A *PER SE* RULE AGAINST COLOR REGISTRATION

Jacobson's brief sets forth a number of policy arguments which are based upon facts not present in this case. In any event, none of these arguments mandate the *per se* rule which Jacobson urges this Court to adopt. Jacobson argues that a color trademark presents the potential for shade confusion, and that this is a sufficient reason for denying trademark protection for a color. The facts in this case belie the universal applicability of that doctrine. Jacobson intentionally copied the exact color of Qualitex's registered

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[12] Jacobson also cites *In re Swift and Co.*, 223 F.2d 950 (C.C.P.A. 1955) and *Plastilite Corp. v. Kassnar Imports*, 508 F.2d 824 (C.C.P.A. 1975) to support its position. These cases were decided by the Court of Customs and Patent Appeals, the predecessor court of the United States Court of Appeals for the Federal Circuit. To the extent that these cases deny the registrability of color, they have been overruled by the Federal Circuit's decision in *In re Owens-Corning Fiberglas Corp.*

green-gold trademark, raising no issue of shade confusion.[13] *See* J.A. 9a-10a. *See also* J.A. 4a and 5a.[14] As discussed in Petitioner's Brief on the Merits, concerns about shade confusion, based on mere conjecture, are insufficient to warrant a categorical refusal to register color marks. Petitioner's Brief at 26-27.

Jacobson argues that federal registration and protection of color trademarks is anti-competitive, taking the position that permitting Qualitex to register its green-gold trademark would give Qualitex an unlawful monopoly. It is sufficient to state that there is no evidence in the record to support such an argument, and Jacobson is barred from raising it for the first time in this Court. *Hormel v. Helvering*, 312 U.S. 552, 556 (1941). Again, Jacobson ignores the findings of the District Court, which found that Qualitex's trademark is an arbitrarily applied color for which there is no competitive need

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[13] Jacobson also worries about the so-called "practical problems" of color description and identification of colors in the Trademark Register. This is merely a technical matter with readily available technical solutions. *See Amicus Brief for the Hand Tools Institute at 20. See also* Laurence B. Ebert, *Trademark Protection in Color: Do It By The Numbers!*, 84 Trademark Rep. 379 (1994).

[14] The Judgment entered by the District Court enjoined Jacobson from "selling press pads made of any fabric using the same green-gold color of the Qualitex press pads, or so close to said color that it cannot be easily distinguished from the Qualitex color by the casual user" (J.A. 21a). This injunction was undisturbed by the Ninth Circuit, which was apparently unconcerned with problems of shade confusion in this case. The breadth of the relief obtained after Jacobson's intentional deceptive conduct in adopting a color identical to that of Qualitex and placing it on inferior goods is hardly a basis for denying registration to Qualitex's green-gold trademark. Numerous cases have held that a defendant caught with its hand in the "cookie jar" must not only remove its hand from the jar, but must also "keep far away from it." *Johnson & Johnson v. Quality Pure Mfg., Inc.*, 484 F. Supp 975, 980 (D.C.N.J. 1979). *See also Chevron Chemical Co. v. Voluntary Purchasing Groups*, 659 F.2d 695, 705 (5th Cir. Unit A Oct. 1981); *Kentucky Fried Chicken Corp. v. Diversified Packaging Corp.*, 549 F.2d 368, 390 (5th Cir. 1977); *Broderick & Bascom Rope Co. v. Manoff*, 41 F.2d 353, 354 (6th Cir. 1930).

(J.A. 12a). There is no evidence or finding in this case that Qualitex has eliminated or even hindered competition in the marketplace by the use of its trademark. Absent such evidence, there is no support in this case for a *per se* rule. Of course, were there evidence that a mark has been or is being used to violate the anti-trust laws, Section 33(b)(7) of the Lanham Act, 15 U.S.C. § 1115, would provide a complete defense to a claim of trademark infringement.

Jacobson's concern that registration of color trademarks would deprive others in the marketplace of colors they need to compete was not shared by either the Ninth Circuit (J.A. 28a) or the District Court (J.A. 14a). The Ninth Circuit recognized that there are countless shades of colors that could not be depleted (J.A. at 28a). The supposed danger of color depletion is no basis for a *per se* rule. Whether there is a competitive need for color is a factual determination to be made in each case. See *Trademark Manual of Examining Procedure*, § 1202.04(e) (2d Ed. 1993). Qualitex has never deprived its competitors of the use of identifying colors they have chosen (J.A. 12a). As with shade confusion, the factual findings in this case fail to support Jacobson's color depletion argument. *See* Petitioner's Brief at 25-26.

Use of the green-gold color on the cover cloth of Qualitex's press pads as a source-identifying trademark does not impede competition; rather it promotes competition by permitting consumers to distinguish between the products of different manufacturers. Other press pad manufacturers are free to add any other color to distinguish and identify their products, and the District Court found that they have indeed done so (J.A. 8a). In this way, color functions as a trademark and promotes healthy competition. *See The United States Trademark Association Trademark Review Commission Report and Recommendations to USTA President and Board of Directors*, 77 Trademark Rep. 375, 421 (1987). Consumers are thus able to avoid confusion in the marketplace. Jacobson's argument that protection of overall color under the Lanham Act

is inherently anti-competitive is simply inconsistent with the use of color in this case and with trademark law principles generally.

Jacobson argues that adequate alternative protection for unregistered color trademarks is available under trade dress theories pursuant to Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), and that, accordingly, color trademarks should not be registrable under the Lanham Act. This argument is without merit. Section 43(a) of the Lanham Act does not provide the owner of a trademark protection equivalent to that provided by § 32.[15] *See* Petitioner's Brief at n. 28. Section 43(a) was intended to expand rather than restrict the protection of § 32 by prohibiting a broader range of practices. See *Two Pesos Inc. v. Taco Cabana, Inc.*, 112 S.Ct. 2753, 2757 (1992); *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 859 (1982). In any event, the availability of alternative protection under common law or § 43(a) is no compelling argument for denying registrability to color. If the availability of Section 43(a) protection were a reason to deny federal registration to a color trademark, it would also be a basis for denial of registration to any mark so protected. That could hardly have been what Congress intended.

C. REGISTRATION OF COLOR TRADEMARKS SERVES THE UNDERLYING POLICIES OF THE LANHAM ACT

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[15] "There is a great distinction between the rights which the owner of federally registered trademark has and those which the owner of an unregistered mark has. A registration carries with it all of the statutory benefits, from constructive notice to prima facie evidence of the exclusive rights to use. A registration may also be eligible for incontestability, which is the highest form of registration protection we have. On the other hand, an unregistered trademark owner has none of those benefits. That distinction would remain in the legislation as proposed." Hearing on H.R. 4156 Before the Subcomm. on Courts, Civil Liberties, and the Administration of Justice of the House Committee on the Judiciary, 100th Cong., 2d Sess. 90-99 (September 8, 1988) (Testimony of Jerome Gilson).

Sound trademark policy supports the registrability of color when it functions as a trademark. Registration of such trademarks serves the underlying policies of the Lanham Act. See Petitioner's Brief at 22. The Petitioner's position is supported by the United States, The U.S. Patent and Trademark Office, the International Trademark Association and six other Amici Curiae. The supporting briefs provide substantial evidence that sound public policy supports the registration of color trademarks.[16]

Qualitex's green-gold color has served as its trademark for over thirty years. To deny the statutory protection it has earned would promote confusion in the marketplace by depriving its customers of the trademark they clearly recognize and rely on in choosing a quality product. Jacobson would have this Court restrict the application of the Lanham Act when no reason for such restriction can be found in the words of the statute, its legislative history, or modern commercial practice. The policies underlying the Lanham Act require that in appropriate circumstances colors be registered as trademarks, to promote competition, to preserve goodwill and to protect consumers from confusion.

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[16] These briefs point out a myriad of policy interests which such registration serves: Color registration will protect the ability of consumers to distinguish between competing producers. Amicus Brief for the Owens-Corning Fiberglas Corp. at 13. Denying exclusive rights and registration to a color which has acquired secondary meaning would promote confusion and deception. Amicus Brief for the Bar Association of the District of Columbia at 5; Amicus Brief for the Intellectual Property Owners at 7; Amicus Brief for the Dr. Pepper/Seven-Up Corporation at 3. Registration of color advances the Lanham Act's objective of registering as many marks in use as practicable so competitors may effectively search the marks in use and avoid conflicts, Amicus Brief for the Intellectual Property Owners at 8. Denying registrability to color is inconsistent with global harmonization in trademark law. Amicus Brief for the Hand Tools Institute at 14-16. Permitting color registration supports the United States' advocacy to other countries that they recognize color as a trademark. Amicus Brief for the United States at 1-2.

IV. CONCLUSION

For the reasons set forth above and in Petitioner's Brief on the Merits, this Court should reverse the decision of the Ninth Circuit to the extent that it ordered cancellation of Qualitex's federal registration.

Respectfully submitted

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